

REMARKS

The Examiner, Dr. Ardin H. Marschel, is thanked for the courtesy of the interview conducted with Applicants' counsel on September 21, 2004. In this Amendment, Applicants have endeavored to present amended claims consistent with the subject matter that the Examiner advised at the interview was directed to patentable subject matter. Accordingly, reconsideration of this application is respectfully requested.

At the end of the interview held on September 21, 2004, the Examiner requested that Applicants provide an interview summary record in their next response. Accordingly, Applicants provide below an interview summary record. A summary of the status of the claims is also provided below indicating canceled claims, amended claims and all pending claims following this amendment.

Interview Summary Record

Purpose of the Interview

The interview began with Applicants' attorney explaining that the purpose of the interview was to discuss and possibly resolve some matters related to Applicants' modified interference request being drafted and Smith's U.S. Patent No. 5,821,058. Applicants' attorney also noted that sequencing claims were presented in the '069 Application more than one and a half years before the issuance of Smith's '058 Patent.

Different Fluorescent Labels and Spectral Characteristics

Applicants' attorney explained that different fluorescent labels and different colored labels are disclosed in Example 9 in the '069 specification, and that these labels provide the spectral characteristics disclosed and claimed in Smith's '058 Patent. The Examiner responded that spectral characteristics could include more than the visible light portion of the [electromagnetic] spectrum. Applicants' attorney pointed out, however, that in column 4, lines 52+ of Smith's '058 Patent, three fluorescent dyes are disclosed [fluorescein, rhodamine and substituted rhodamine], and that the same fluorescein and rhodamine are disclosed in the '069 specification, and were even originally

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This paper follows a brief telephonic interview held on January 20, 2005 between Examiner Ardin H. Marschel, Ph.D.² and Applicants' undersigned attorney. During the telephone call, the possibility of canceling several claims and amending other claims was discussed for the purpose of narrowing, if not resolving, the outstanding issues in this application. Thus, this paper implements the substance of that interview.

I. Claim Changes

A. Claim Cancellations

As discussed during the telephonic interview, Applicants have canceled, by this paper, claims 1298-1328, 1331-1332, 1334-1351, 1353-1354, 1357-1358, 1360, 1362-1369, 1372-1380, 1383, 1386-1391, 1393-1407, 1409-1410, 1583-1585, 1587, 1592-1612, 1614-1615, 1618-1621, 1623-1628, 1631-1632, 1635-1647, 1649-1656, 1658, 1660-1667, 1670-1677, 1679-1680, 1682, 1685-1699 and 1725-1726. The cancellation of these claims has been done without prejudice or disclaimer to Applicants' right to pursue the subject matter of these claims at some future yet undefined point in time. Claims 1298 *et seq.* were directed to a process for detecting a nucleic acid of interest; and claims 1582 *et seq.* were directed to a process for preparing a detectable non-radioactively labeled oligo- or polynucleotide of interest. In each of claims 1298 and 1582, *Sig.*, the detectable non-radioactive label moiety was recited to be "non-nucleotidyl." With the aforementioned cancellations, the blocks of claims running from 1298-1410 and 1582-1699 have been canceled. Two other claims that formerly depended from now canceled claims have also been canceled. These include claims 1758 and 1759. Both recited dependencies from "claims 1373 or 1671."

² Dr. Marschel was recently appointed Supervisory Patent Examiner (SPE) for Group Art Unit 1631.

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Claims 59, 60 and 61 have been amended and claim 62 has been newly added. No amendments have been made to obviate prior art. Support for the amendments and the new claim is found generally. Accordingly, the amendments and the new claim raise no issue of new matter.

Interview Summary

Applicants thank Examiner Marschel for the courtesies extended in the telephonic interview of November 30, 2004 where issues raised by the Examiner in the Advisory Action mailed April 7, 2004 were discussed. The amendments and remarks herein reflect the discussion of the April 11, 2005 interview, and the conclusion that such submission may place the case in condition for allowance.

Applicants wish to clarify on the record an apparent misunderstanding about a previous telephonic interview held on January 5, 2005, which was referenced in an Amendment After Final Rejection filed by the Applicants on January 5, 2005. Specifically, a statement at page 2 of the Advisory Action mailed April 7, 2005, suggests that the January 5, 2005 interview had not taken place. This conclusion was reached by Examiner Marschel because he did not recollect the meeting and because there was no Examiner Interview Summary Record in the USPTO case file. However, during the interview of April 11, 2005, Examiner Marschel indicated that his Examiner interview summary of January 5, 2005 had apparently reached the file after he completed the Advisory Action. Examiner Marschel stated in the interview of April 11, 2005 that he now agrees with the Applicants that the interview of January 5, 2005 had indeed taken place.

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